

IV. Remarks.

The Examiner entered the following rejections.

1. Claims 13-18 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 refers to a "rotating shaft" in the first limitation and to a "second rotating shaft" in the second limitation. Applicant respectfully asserts this is not ambiguous since the "first" shaft is clear from the context even if it is not specifically labeled as such. Applicant requests this rejection be withdrawn.

2. Claims 13 and 18 are rejected under 35 USC 103(a) as being unpatentable over Monahan et al (5,827,143).

A rejection based on 35 U.S.C. § 103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. *Interconnect Planning Corp. v. Fiel*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed.Cir. 1985); *In Re Corkhill*, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed.Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. *Environmental Designs v. Union Oil Co. of Cal.*, 713 F.2d 693, 698 (Fed.Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. *American Hoist & Derek Co. v. Sowa & Sons, Inc.*, 220 U.S.P.Q. (BNA) 763, 771 (Fed.Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit recently noted, "[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *Ecolchem, Inc. v. Southern Calif. Edison*, 56 U.S.P.Q. 2d 1065, 1073 (Fed.Cir. 2000). There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir. 1999). This is because "combining prior art references without evidence of such a suggestion,

teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." *Id.* Accordingly, to establish a rejection under 35 U.S.C. § 103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir. 1998).

Obviousness also entails a review of the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1996) namely, 1) determining the scope and content of the prior art, 2) ascertaining the differences between the claimed invention and the prior art, and 3) resolving the level of ordinary skill in the pertinent art.

In a recent case where the patent in suit was found invalid, the Supreme Court observed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KRS International Co. v Teleflex Inc.* 127 S.Ct. 1727, 82 USPQ 2d 1385 (2007). The court stated:

"Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (emphasis added) *Id.* at 1741.

As to claim 13, the Applicant respectfully disagrees with the elements identified by the Examiner. To put the argument in context, claim 13 recites a "clutch unit directly connected to an accessory rotating shaft" in the first limitation and a separate "one-way clutch directly connected to a second rotating shaft" in the second limitation. Two distinct clutches as well as two distinct rotating shafts are present in claim 13. Each element must be taught by the cited reference in order for the reference to support the rejection. It is on this basis that Monahan fails.

In particular, the Examiner argues that Monahan teaches a "clutch unit" limitation, specifically citing for this proposition item (14), see Fig. 3. However, Monahan teaches that item (14) is a "belt", see 4:30, and not a "clutch" as proposed. Belt (14) is more clearly shown in Fig. 2. Therefore, the "clutch" limitation attributed to item (14) is not taught. Consequently, Monahan cannot teach a clutch unit directly connected to an accessory rotating shaft.

Further, the Examiner argues that Monahan teaches the second limitation in the form of a "clutch unit (24) directly mounted to a second shaft (40)". A close inspection of Fig. 3 reveals that clutch (80) is directly mounted to hub (42).¹ This arrangement is in conflict with the teaching argued by the Examiner as to the "clutch" (14) and "shaft" (42), namely, the Examiner's argument appears to place both "clutch (14)" and "clutch (24)" on shaft (42). However, this is not the arrangement taught by Monahan since there is no "clutch (14)".

Considering the device in Fig. 3 in its entirety, Monahan only teaches a single one-way clutch, namely, one-way clutch mechanism (80) mounted to a hub (42), see 5:32-33. There is no second clutch mechanism of any kind taught by the device in Fig. 3. Therefore, all of the limitations of claim 13 are not taught by Monahan and so Monahan cannot sustain the 103(a) rejection.

Applicant requests that the rejection be withdrawn.

Claim 18 depends from claim 13.

3. Claims 9, 11-12 and 14-17 are rejected under 35 USC 103(a) as being unpatentable over Monahan et al in view of JP (11-280873).

As to the limitations of claim 9, the deficiencies of Monahan are argued above. Further, claim 9 includes limitations directed to "a clutch unit directly mounted to a rotating shaft; and a one-way clutch comprising a damper, the one-way clutch directly mounted to the rotating shaft". Unlike claim 13, claim 9 places the "clutch unit" and "one-way clutch" in a single rotating shaft. However, Monahan Fig. 3 only teaches a single "one-way clutch" (80) on the "rotating shaft" (42). The second "clutch unit" as claimed is absent from Monahan.

The second reference, JP '873, is only offered for the proposition of providing a rubber damper (6) and an inertia member (83). Consequently, JP '873 does not cure the lack of teaching of Monahan as to the clutch unit. This in turn negates any motivation to combine the references since all limitations must be taught or suggested by the references before motivation can be found.

Claims 11-12 depend from claim 9. Claims 14-17 depend from claim 13.

¹ Hub (42) is fixedly threaded onto shaft (40), see 4:60-65.

V. Fees.

Any fees payable for this response may be deducted from deposit account 070475 in the name of the Gates Corporation.

Thank you for your attention to this case.

Sincerely,



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